

REMARKS

This paper is submitted in response to the Office Action mailed March 30, 2009. At that time claims 1-4, 6-8, 10-13 and 15-18 were pending.

In the Office Action claims 8 and 10-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Petta (United States Patent No. 6,745,523, hereinafter "Petta"). Claims 1-3, 6-7, 13 and 15-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Petta, and claims 1 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carson (United States Patent No. 3,927,492, hereinafter "Carson").

By this paper claims 1, 8, 13 and 18 have been amended. Accordingly, claims 1-4, 6-8, 10-13 and 15-18 are presented for reconsideration and allowance by the Examiner.

Interview with Examiner A

Applicants express appreciate to Examiner Phi Dieu Tran A for conducting a telephonic interview with Applicant's attorneys David B. Tingey and David R. Conklin on May 12, 2009. At that time the application as pending was discussed. The claims were discussed, particularly proposed independent claims 1. The outstanding office action and the cited prior art were discussed. In particular, the Petta and Carson references were discussed. The differences between the cited art and the invention were discussed and approaches to the claims were discussed, including those set forth in the amended claim set above.

Rejections Under §102 in view of Petta

In the Office Action mailed from the United States Patent and Trademark Office on March 30, 2009, the Examiner rejected claims 8 and 10-12 as being anticipated by Petta. In particular, the Examiner has suggested that Petta anticipates an "elongate core substrate (94)...having a lateral plate (118) and a flange (96) perpendicularly coupled to the lateral plate,

the flange intersecting the elongate lateral plate to provide a first portion and a second portion to provide a cross-sectional t-shape, said elongate lateral plate being coupled to the interior facing wall in the first plane, the flange extending outwardly from the elongate lateral plate in a second plane that is substantially perpendicular to the first plane.” Office Action, page 2, lines 18-25. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 (*quoting Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.* (*quoting Richardson v. Suzuki Motors, Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Applicant respectfully submits that Petta does not teach or suggest each and every element as set forth in the rejected claims, as amended above. Accordingly, Applicants will address separately each element of the present invention which were rejected over Petta under 35 U.S.C. §102.

Orientation of the Interior Facing Wall Surface Element

Applicant respectfully submits that currently amended independent claim 8 and the respective dependent claims 10-12 are not anticipated by the Petta reference. In particular, amended claim 8 claims “a windowpane generally positioned within the window opening in a first plane” and includes the further limitation “wherein said elongate lateral plate is directly coupled to an interior facing wall surface having a second plane that is substantially parallel to the first plane of the windowpane.” See amended claim 8, above. A representative embodiment of an interior facing wall surface (8) is clearly illustrated in Figures 1, 2, 7 and 9 of the Applicant’s application. The interior facing wall surface (8) is shown in a plane that is substantially parallel to a plane of the window surface (4) of the windowpane (2) which is

positioned within a window jamb 6 inside a window opening (see Figures 1, 2 and Specification [0033] – [0034]). Conversely, Petta is entirely devoid of any teaching of a lateral plate that is directly coupled to an interior facing wall surface as structurally claimed. Applicant respectfully submits that claim 8 has been amended to structurally clarify the orientation of the interior wall surface to include “a second plane that is substantially parallel to the first plane of the windowpane.” As such, the orientation of the lateral plate and flange of the elongate core substrate taught by the Applicant and described in claim 8 is not found in nor anticipated by Petta. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 8 and dependent claims 10-12.

Window Covering Element

Claim 8 is further amended to claim “a window covering directly coupled to a second portion of said flange, wherein said window covering is capable of substantially covering said windowpane.” A representative embodiment of a window covering (14) is shown in Figure 1 (in phantom) and Figure 7 of the Applicant’s application. A detailed description of the window covering, including various possible embodiments thereof, is disclosed in paragraphs [0032] – [0034] of the Applicant’s specification. Conversely, Petta is entirely devoid of any teaching of a window covering that is directly coupled to a second portion of a flange, and is further completely devoid of any teaching of a window covering that is capable of substantially covering a windowpane. Furthermore, as previously discussed, Petta fails to teach, suggest or disclose a lateral plate that is directly coupled to an interior facing wall surface as structurally claimed by the Applicant in combination with the window covering. Accordingly, since Petta fails to teach each and every element as set for the in claim 8, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 8 and dependent claims 10-12 over Petta.

Rejections under 35 U.S.C. §103 over Petta

The Examiner entered a rejection of claims 1-3, 6-7, 13 and 15-18 under 35 U.S.C. §103(a) over Petta. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007).)

As discussed above with reference to the §102 rejection of claim 8 over Petta, both the orientation of the interior facing wall surface element and the window covering element are entirely missing in Petta (*see* arguments above). As amended, independent claims 1, 13 and 18 of the present application also include these elements as found in amended claim 8. Thus, Applicant respectfully submits that Petta fails to teach a lateral plate that is directly coupled to an interior facing wall surface as structurally claimed by the Applicant in independent claims 1, 13 and 18. Furthermore, Applicant respectfully submits that Petta fails to teach the lateral plate element in combination with a window covering that is capable of substantially covering a windowpane, as structurally claimed by the Applicant in independent claims 1, 13 and 18. Finally, since Petta does not teach either the claimed elements of claims 1, 13 and 18, or teach how or why one would include, orient or modify the elements as claimed, the Applicant respectfully submits that the claims 1, 13 and 18 are not obvious over Petta.

With reference to dependent claims 2-3, 6-7 and 15-17, Applicant respectfully submits that because independent claims 1, 13 and 18 are not made obvious over Petta, the claims

depending from these independent claims are also not made obvious over Petta. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-3, 6-7, 13 and 15-18 over Petta.

Rejections under 35 U.S.C. §103 over Carson

The Examiner further entered a rejection of claim 1 and 4 under 35 U.S.C. §103(a) over Carson. In addition to those amendments already discussed in connection with independent claims 1, 8, 13 and 18, independent claim 1 has been amended to include the further limitation of “the flange intersecting the elongate lateral plate to provide a first portion and a second portion to provide a cross-sectional t-shape, wherein the first and second portions are generally in the same plane.” A representative embodiment of the first and second portions of the lateral plate, generally in the same plane, is clearly illustrated in Figures 4 and 6 of the Applicant’s application.

Applicant respectfully submits that claim 1, as currently amended, is not obvious over Carson. In particular, Carson fails to contain any teaching of how or why one would include a lateral plate directly coupled to an internal facing wall surface as structurally claimed in claim 1. Furthermore, Carson fails to contain any teaching of how or why one would directly attach a window covering to the outwardly extended flange, wherein the window covering is capable of substantially covering a windowpane, as also structurally claimed in claim 1. Finally, Carson fails to teach how or why one would directly couple a connecting channel to at least one of a first face of a flange and a first portion of a lateral plate, as structurally claimed in claim 1.

For at least these reasons, Applicant respectfully submits that claim 1, as presently amended, is not made obvious over Carson, and accordingly requests that the Examiner

withdraw the rejection of claim 1 over Carson. Furthermore, since claim 4 depends directly from claim 1, Applicant respectfully submits that claim 4 also is not made obvious over Carson, and respectfully requests that the Examiner withdraw the rejection of claim 4 over Carson.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 15th day of May, 2009.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'D. B. TINGEY', is written over a horizontal line.

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